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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,608	08/19/2003	Christopher J. Ryan	8932-785-999	8166
51832 7590 02/20/2007 JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 02/20/2007	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/642,608

**Applicant(s)**

RYAN, CHRISTOPHER J.

**Examiner**

Pedro Philogene

**Art Unit**

3733

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,5,7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,360,405) in view of Yoon (5,882,340).

Yoon '405 discloses in FIG.1 a shaft (32) with a cutting edge, an outer tapered sleeve (34), and a biasing member/spring (70), which biases the shaft (32) in the retracted position. The shaft is limited in its axial extension relative to the sleeve (34). The shaft is fully capable of being rotated relative to the sleeve since the sleeve and shaft are detachable (column 5, lines 62-66). The device comprises a shoulder (50) and handle including the enclosure of element (36).

It is noted that Yoon '405 did not teach of at least one aperture in the wall of the outer sleeve; as claimed by applicant. However, in a similar art, Yoon '340 evidences the use of a, outer sleeve with at least one aperture to allow the shaft to expand from a retracted to an extended position.

Therefore, given the teaching of Yoon '340, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Yoon '405, as taught by Yoon '340, to allow the shaft to expand from a retracted to an extended position.

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Claims 1, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deniega et al. (5,066,288) in view of Yoon (5,882,340).

Deniega et al disclose in FIG.3 a shaft (24) having a cutting edge, an outer sleeve (10), a biasing member/spring (30), a shoulder and a handle.

It is noted that Deniega et al did not teach of at least one aperture in the wall of the outer sleeve; as claimed by applicant. However, in a similar art, Yoon evidences the use of a, outer sleeve with at least one aperture to allow the shaft to expand from a retracted to an extended position.

Therefore, given the teaching of Yoon, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deniega et al, as taught by Yoon, to allow the shaft to expand from a retracted to an extended position.

Claims 4, 9, 10,12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,360,405) in view of Yoon (5,882,340) in view of Yoon (5,591,190).

It is noted that the above combination of references did no teach of an external threads on the outer sleeve; as claimed by applicant. However, in a similar art, Yoon '190 evidences in FIGS.15-16 the use of threads on the outer sleeve to provide relatively slower penetration with greater control of penetration and depth and is particularly advantageous for thoracic and brain surgery.

Therefore, given the teaching of Yoon '190, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include external

threads on the sleeve of Yoon/Yoon, as taught by Yoon '190, to provide slower penetration with greater control of penetration and depth.

Claims 4, 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deniega et al. (5,066,288) in view of Yoon (5,882,340) in view of Yoon (5,591,190).

It is noted that the above combination of references did not teach of an external threads on the outer sleeve; as claimed by applicant. However, in a similar art, Yoon '190 evidences in FIGS. 15-16 the use of threads on the outer sleeve to provide relatively slower penetration with greater control of penetration and depth and is particularly advantageous for thoracic and brain surgery.

Therefore, given the teaching of Yoon '190, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include external threads on the sleeve of Deniega/Yoon, as taught by Yoon '190, to provide slower penetration with greater control of penetration and depth.

#### ***Response to Amendment***

Applicant's arguments, see Remarks, filed 11/22/06, with respect to the rejection(s) of claim(s) 1-16 under 102/103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yoon '340.

#### ***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
February 9, 2007

  
Pedro Philogene